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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,276	04/13/2005	Yoshiyuki Kohno	35355/53	5069
23838	7590	07/19/2007		
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
			EXAMINER MATOCHIK, THOMAS L	
			ART UNIT 1709	PAPER NUMBER
			MAIL DATE 07/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/531,276	Applicant(s) KOHNO ET AL.	
	Examiner Thomas Matochik	Art Unit 1709	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Election/Restrictions*

Applicant's election without traverse of Group I, claims 1-7 in the reply filed on 6/25/2007 is acknowledged.

Claims 8 and 9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 25, 2007.

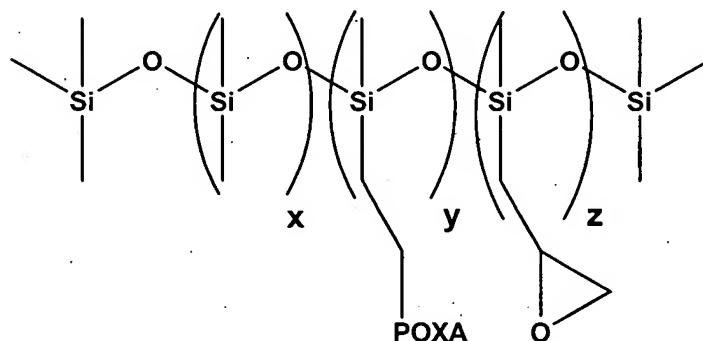
### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Pines et.al (US4,184,004).

Regarding claim 1: Pines teaches a polymer,  $MD_xD'_yD''_zM$  where M of formula I (col. 2, line 13) is  $(CH_3)_3SiO_{0.5}$  (col. 2, line 16), D is  $(CH_3)_2SiO$  (col. 2, lines 29-32), D' is  $CH_3R^1SiO$  (col. 2, lines 45 & 34), wherein  $R^1$  is a polyoxyalkylene unit (col. 2, line 47) and D'' is  $CH_3R^2SiO$  (col. 2, lines 67 & 34), wherein  $R^2$  is a monovalent organic radical containing at least one vicinal epoxy group (col. 2, line 68). Additionally, wherein  $x = 10$ ,  $y = 1$  to  $x$  and  $z = 1$  (col. 3, lines 13-50). See figs. 1 and 2 below.

fig. 1  
Reference US Patent # 4,184,004

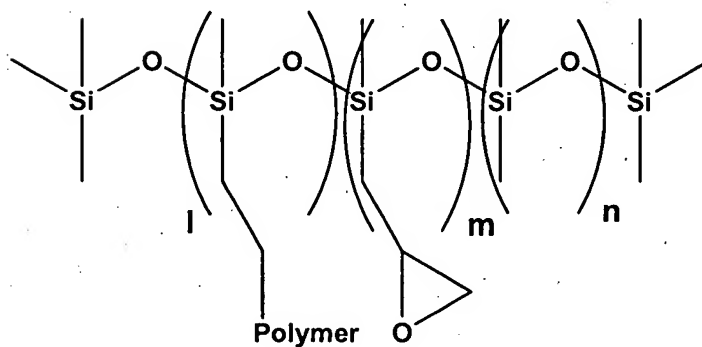


$x = 10 \text{ to } 5000$

$y = 1 \text{ to } x$

$z = 1 \text{ to } 0.5x$

fig. 2  
Application # 10/531,276



$l = 1$

$l \leq m+n \leq 50 = 0$

$l \leq m$

$0 \leq n$

Regarding claims 2 and 3: Pines teaches a polymer with a monovalent organic radical containing an epoxy group with a ether linkage between the hydrocarbon group and the epoxy group (col. 3, lines 30-34).

Regarding claim 5: Pines teaches a polymer wherein the main polymer skeleton comprises a polyoxyalkylene polymer (col. 4, lines 30-34).

Regarding claim 6 and 7: Product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. If the product in the product-by-process claim is the same as or obvious from a product of the prior

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art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pines (US 4,184,004 as applied to claims 1-3 and 5-7 above, and further in view of Umpleby (US 4,803,244).

Pines teaches the basic claimed polymer as set forth above.

Regarding claim 4: Pines does not teach a polysiloxane copolymer with a skeleton portion comprising a saturated hydrocarbon polymer selected from the group consisting of polyisobutylene, hydrogenated polyisoprene, hydrogenated polybutadiene and hydrogenated copolymers thereof. However, Umpleby teaches hydrosilation chemistry commonly used in the art to form polyolefinic/polysiloxane copolymers (col. 2, lines 58-65 and col.3, lines 8-23). Pines and Umpleby are analogous art because they are from the same field of endeavor, namely organosilicone polymers. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine hydrosilation chemistry to produce polysiloxane/polyolefinic epoxide containing

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copolymers with the invention of Pines, because the inclusion of hydrophobic polyolefins will provide stain resistant polymeric materials.

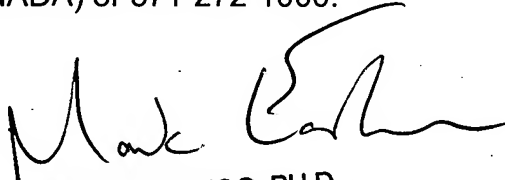
### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Matochik whose telephone number is 571-270-3291. The examiner can normally be reached on Monday-Friday 7:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLM

  
MARK EASHOO, PH.D.  
SUPERVISORY PATENT EXAMINER  
12/Jul/07